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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,359	03/16/2001	Taeyoung Yoon	49662 [72021]	7721

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EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

11

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,359

Applicant(s)

YOON ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-21, and 23 is/are rejected.
- 7) ☒ Claim(s) 4, 22, 24-68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment of 11-20-02 has been considered. While the amended claims have obviated the previous rejections of 112/1st and 2nd paragraph, they have introduced new matter and other issues of indefiniteness. Also, an update search yields a reference with relevant subject matter which necessitates the following new ground of rejection.

Claims 1-68 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **New Matter:** Claims 3, 9, 10, 13-15, 17, 19, and 20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Said claims recite the limitation of "(cycloalkyl)alkyl groups consisting of 4 to 12 carbon atoms". While there is support for (cycloalkyl)alkyl groups up to 10 carbon atoms, there is no support for said groups with more than 10 carbon atoms.

2. Claims 5-8, 11, 12, 16, 18, 21 and 23 are also rejected under 35 U.S.C. 112, first paragraph because they carry over limitations of claims 3, 9, 10, 13-15, 17, 19, and 20.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 5-21, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a. Claims 3, 9, 15 recite the definition for X which have double inclusions such as the following:

- i. $-\text{CH}_2-$ vs. $-\text{CHR}_B$ (wherein R_B is hydrogen);
- ii. $-\text{S}(\text{O})_n\text{NH}-$ vs. $-\text{S}(\text{O})_n\text{NR}_B-$ (wherein R_B is hydrogen);
- iii. $-\text{NHC}(=\text{O})-$ vs. $-\text{NR}_B\text{C}(=\text{O})-$ (wherein R_B is hydrogen);
- iv. $-\text{NHS}(\text{O})_n-$ vs. $-\text{NR}_B\text{S}(\text{O})_n-$ (wherein R_B is hydrogen); etc.

b. Claims 3 and 9 recite limitations with a unmatched parenthesis such as:

$-\text{S}(\text{O})_n(\text{C}_{1-6}\text{alkyl})$, $-\text{OSiH}_n(\text{C}_{1-4}\text{alkyl}_{2-n})$.

c. Claims 3, 9, and 15 recite a limitation of $-\text{OsiH}_n(\text{C}_{1-4}\text{alkyl}_{2-n})$, which might have parenthesis in the wrong place.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Murata et. al.** (US 5,972,946). On column 29, Murata et. al. disclose many intermediates that are analogous to those compounds recited in the above claims (e.g., see compounds #22-30 in Table II). Said compounds differ from those claimed herein by having a chloro group in the position of the instant variable R₃. Although "chloro" is not a choice for the instant R₃, one skilled in the art still would have been motivated to make analogs of compounds #22-30 having another halogen in place of "chloro" since halogens share the same chemical and physical properties as a leaving group. Thus, at the time of the invention, it would have been obvious to make some compounds in claims 1 and 2 in view of the teaching of **Murata et. al.**

Claim Objections

5. Claims 4, 22, 24-68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9:00-5:30).

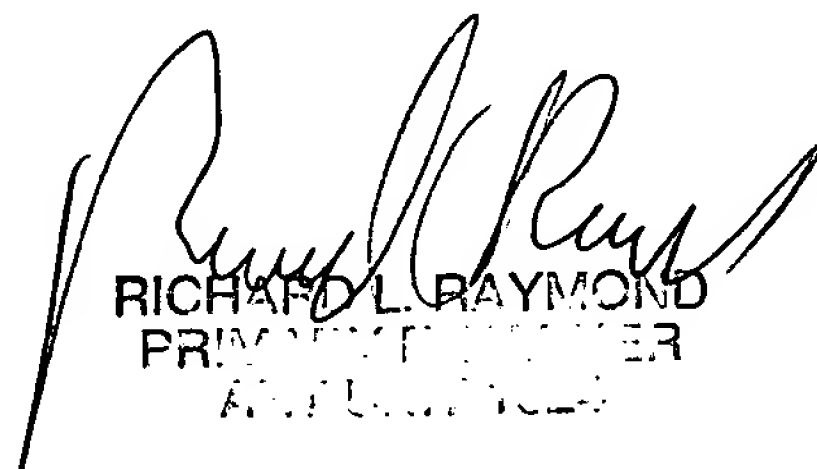
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

January 26, 2003



RICHARD L. RAYMOND
PRIMARY EXAMINER
ART UNIT 1624